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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,746

03/29/2004

Jacob Guth

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5468

7278

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05/13/2008

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EXAMINER

MARX, IRENE

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

05/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,746	<b>Applicant(s)</b> GUTH ET AL.	
	<b>Examiner</b> Irene Marx	<b>Art Unit</b> 1651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1 and 4-19 is/are pending in the application.  
     4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-10 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 3/13/08 is acknowledged.

The amendment filed 8/27/07 is acknowledged. Claims 1, 4-10, 14-19 are being considered on the merits

Claims 11-13 are withdrawn from consideration as directed to a non-elected invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 10, 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Elliott *et al.* (U.S. Patent Publication No. 2003/0175232).

The claims are directed to a topical composition comprising L-carnitine and/or an acyl L-carnitine or their salts and one or more of hydroxy acids, proteolytic enzymes, skin lightening agents as topical preparations having a pH of about 6 to about 8.

Elliott *et al.* disclose a topical composition comprising L-carnitine and one or more of proteolytic enzymes, which is a suitable additive, as topical preparations having a pH of about 6 to about 8 and comprising enzymes having an optimum pH of about 6 to about 7. See, e.g., table at page 16.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-10, 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (U.S. Patent No. 6,149,924) in view of Elliott *et al.* (U.S. Patent Publication No. 2003/0175232), Cavazza *et al.* (EP 0631779), Johnsen (US patent 3,683,939), Vromen (US patent 6,416,759), Yu *et al.* (US patent 5,589,505) and Deckner *et al.* (U.S. Patent No. 5,968,528).

The claims are directed to a topical composition comprising L-carnitine and/or an acyl L-carnitine or their salts and one or more of hydroxy acids, proteolytic enzymes, skin lightening agents as topical preparations having a pH of about 6 to about 8.

Paul discloses topical compositions comprising L-carnitine and a hydroxy acid. See, e.g., col. 3 and 6. Glycolic acid is a preferred hydroxy acid (col. 15, line 16).

In addition, Elliott *et al.* disclose a topical composition comprising L-carnitine and one or more of proteolytic enzymes, which is a suitable additive, as topical preparations having a pH of about 6 to about 8 and comprising enzymes having an optimum pH of about 6 to about 7. See, e.g., table at page 16.

The reference differs from the invention as claimed in the presence of various components.

However, Cavazza discloses the use of various additives in cosmetic compositions. See, e.g., page 8. In addition, Johnsen discloses that the pH for cosmetics is favorable in the range of 5.5 to 7 (col. 5). In addition, Vromen adequately demonstrates that proteolytic enzymes such as papain are routinely added to cosmetic or topical compositions. See, e.g., col. 2.

With regard to the use of skin bleaching agents, Yu *et al.* adequately demonstrate that it is old in the art to add various materials to cosmetic compositions, such as skin bleaches. See, e.g., col. 2. In addition, Deckner *et al.* teach the specific skin lighteners kojic acid and arbutin (col. 31, lines 40-60). This reference also discloses the use of hydroxy acids such as salicylic, glycolic and lactic in topical compositions. See, e.g., col. 31, lines 1-12. Moreover, the use of

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carnitine in such compositions is disclosed at col. 24, line 22. Deckner teaches that the pH should preferably be between 5 to 8. (Col. 10, line 15.)

It would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the compositions of Paul containing L-carnitine by using various additives to the cosmetic composition and keeping the pH at between 5.5 and 7 for example, and using various additives such as proteolytic enzymes, bleaches, lighteners, etc. as suggested by the teachings of Cavazza et al., Johnsen, Vromen, Yu et al. and Deckner *et al.* for the expected benefit of providing a topical composition suitable for rejuvenating ageing skin.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

### **Response to Arguments**

Applicant's arguments as they pertain to the above rejection have been fully considered but they are not deemed to be persuasive.

Applicant argues that a pH of about 6 to 8 has unexpectedly improved exfoliating performance. However, Elliott *et al.* disclose a topical composition comprising L-carnitine and one or more of proteolytic enzymes, which is a suitable additive, as topical preparations having a pH of about 6 to about 8 and comprising enzymes having an optimum pH of about 6 to about 7. See, e.g., table at page 16.

In addition, the invention as claimed does not require the presence of an exfoliating enzyme such as papain. The invention as claimed requires

- (a) at least one compound selected from (i) L-carnitine, (ii) an acyl L-carnitine, (iii) a salt of L-carnitine thereof, and (iv) a salt of an acyl L-carnitine or a mixture thereof and
- (b) one or more hydroxy acids, proteolytic enzymes, skin lightening agents, or a mixture thereof.

There is no clear requirement for a proteolytic enzyme and the nature and amount thereof are not part of the claimed invention. Thus a pH correlation with exfoliation is not material to the invention as claimed, since a composition comprising an effective amount of papain, for example, is not the claim designated invention. Moreover, the only composition comprising papain and L-carnitine at pH 7 is disclosed at Specification [0085]-[0087]. The composition of interest contains specific amounts of L-carnitine and papain and does not appear to comprise one

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or more hydroxy acids or skin lightening agents the effect of which on pH and exfoliating activity cannot be assessed.

The scope of the showing must be commensurate with the scope of claims to consider evidence probative of unexpected results, for example. In re Dill, 202 USPQ 805 (CCPA, 1979), In re Lindner 173 USPQ 356 (CCPA 1972), In re Hyson, 172 USPQ 399 (CCPA 1972), In re Boesch, 205 USPQ 215, (CCPA 1980), In re Grasselli, 218 USPQ 769 (Fed. Cir. 1983), In re Clemens, 206 USPQ 289 (CCPA 1980). It should be clear that the probative value of the data is not commensurate in scope with the degree of protection sought by the claim.

Therefore the rejection is deemed proper and it is adhered to.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/  
Primary Examiner  
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